

REMARKS

Entry of the foregoing, reexamination and further and favorable reconsideration of the subject application in light of the following remarks, pursuant to and consistent with 37 C.F.R. § 1.112, are respectfully requested.

Summary

As is correctly reflected in the Office Action Summary, Claims 1-30 are pending. Claims 1-17 stand rejected. Claims 18-30 have been withdrawn from consideration. Acknowledgment has been made to Applicants' claim for foreign priority under 35 U.S.C. § 119 (a)-(d) or (f) and all certified copies of the priority documents have been received.

Summary of Amendments

By the foregoing amendments, Claims 2-5 have been canceled without prejudice or disclaimer. Claim 1 has been amended to include the ascorbic acid precursors contained in now-canceled Claims 4 and 5, and to include that the precursor is converted to ascorbic acid. Support for this amendment can be found at least at Page 1, Lines 15-18, of the Specification. No new matter has been added.

Also by the foregoing amendments, Claims 6-8 and 13-17 have been amended to correct minor, typographical, formalistic, and linguistic errors. No new matter has been added.

Finally by the foregoing amendments, Claims 31-35 have been added. Support for Claims 31 and 32 may be found in at least original Claims 9 and 10. Support for Claim 33 may be found in at least original Claim 8. Support for Claim 34 may be found in at least

original Claim 1. Support for new Claim 35 can be found at least in original Claim 13.

No new matter has been added.

Rejections Under 35 U.S.C. § 112, Second Paragraph

Claims 1-17 were rejected under 35 U.S.C. § 112, Second Paragraph, as purportedly indefinite. These rejections are respectfully traversed.

Not to acquiesce in the Examiner's rejections, but solely to facilitate prosecution, Applicants have amended Claims 1, 6-8, and 13 to better define Applicants' invention. Applicants maintain that these amendments have rendered moot the outstanding 35 U.S.C. § 112, Second Paragraph, rejections. Accordingly, withdrawal of these rejections is respectfully requested.

Rejections Under 35 U.S.C. § 102

A. Claims 1-3 and 8 over U.S. Patent No. 5,945,447 to Fallick

Claims 1-3 and 8 have been rejected under 35 U.S.C. § 102(b) as purportedly anticipated by U.S. Patent No. 5,945,447 to Fallick ("Fallick"). This rejection is respectfully traversed.

Not to acquiesce in the Examiner's rejection, but solely to facilitate prosecution, Claims 1 and 8 have been amended to include the specific ascorbic acid precursors found in former Claim 4. Applicants maintain that the amendment of Claims 1 and 8 renders moot the 35 U.S.C. § 102(b) rejection over Fallick. This is because to anticipate a claim, a single source must contain all of the elements of the claim. *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1379 (Fed. Cir. 1986). Fallick fails to disclose at least the elements of Claim 4 which are now elements of Claim 1 and 8.

Accordingly, Applicants respectfully request withdrawal of the 35 U.S.C. § 102(b) rejection of Claims 1 and 8 over Fallick.

B. Claims 1-3 and 8 over Hadas (Derwent Publication 1993-068301)

Claims 1-3 and 8 were rejected under 35 U.S.C. § 102(b) as purportedly anticipated by Derwent Publication 1993-068301 to Hadas et al. ("Hadas"). This rejection is respectfully traversed.

Not to acquiesce in the Examiner's rejection, but solely to facilitate prosecution, Claims 1 and 8 have been amended to include the specific ascorbic acid precursors found in former Claim 4. Applicants maintain that the amendment of Claims 1 and 8 renders moot the 35 U.S.C. § 102(b) rejection over Hadas. As discussed above, for Hadas to anticipate Claims 1 and 8, it must contain all elements of these claims. *Hybritech*, 802 F.2d at 1379. Hadas fails to disclose at least the elements of Claim 4 which are now elements of Claim 1 and 8.

Accordingly, Applicants respectfully request withdrawal of the 35 U.S.C. § 102(b) rejection of Claims 1 and 8 over Hadas.

C. Claims 1-3, 8, and 16-17 over U.S. Patent No. 5,122,536 to Perricone

Claims 1-3, 8, and 16-17 were rejected under 35 U.S.C. § 102(b) as allegedly anticipated by U.S. Patent No. 5,122,536 to Perricone ("Perricone"). This rejection is respectfully traversed.

Not to acquiesce in the Examiner's rejection, but solely to facilitate prosecution, Claims 1, 8, and 16-17 have been amended to include the specific ascorbic acid precursors found in former Claim 4. Applicants maintain that the amendment of Claims 1, 8, and 16-17 renders moot the 35 U.S.C. § 102(b) rejection over Perricone. For Perricone to anticipate Claims 1, 8, and 16-17, it must contain all elements of these claims. *Hybritech*,

802 F.2d at 1379. Perricone fails to disclose at least the elements of Claim 4 which are now elements of Claim 1, 8, and 16-17. Moreover, the composition of Perricone does not contain enzymes, as in the presently claimed invention. Rather, the compositions of Perricone react with enzymes already present on the skin.

Accordingly, Applicants respectfully request withdrawal of the 35 U.S.C. § 102(b) rejection of Claims 1, 8, and 16-17 over Perricone.

D. Claims 1-3 and 8-17 over U.S. Patent No. 6,153,205 to Boussouira

Claims 1-3 and 8-17 were rejected under 35 U.S.C. § 102(b) as purportedly anticipated by U.S. Patent No. 6,153,205 to Boussouira et al. ("Boussouira"). This rejection is respectfully traversed.

Not to acquiesce in the Examiner's rejection, but solely to facilitate prosecution, Claims 1 and 8-17 have been amended to include the specific ascorbic acid precursors found in former Claim 4. Applicants maintain that the amendment of Claims 1 and 8-17 renders moot the 35 U.S.C. § 102(b) rejection over Boussouira. For Boussouira to anticipate Claims 1 and 8-17, it must contain all elements of these claims. *Hybritech*, 802 F.2d at 1379. Boussouira fails to disclose at least the elements of Claim 4 which are now elements of Claim 1 and 8-17.

Accordingly, Applicants respectfully request withdrawal of the 35 U.S.C. § 102(b) rejection of Claims 1 and 8-17 over Boussouira.

Rejections Under 35 U.S.C. § 103

Claims 1-17 stand rejected under 35 U.S.C. § 103(a) as purportedly unpatentable over several publications. These rejections are respectfully traversed.

When applying 35 U.S.C. § 103, four tenets of patent law must be adhered to:

(1) the claimed invention must be considered as a whole, (2) the references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination, (3) the references must be viewed without the benefit of impermissible hindsight vision, and (4) a reasonable expectation of success is the standard with which obviousness is determined. *See MPEP § 2141*, citing *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 (Fed. Cir. 1986). Moreover, to establish a *prima facie* case of obviousness, three basic criteria must be met: (1) there must be some suggestion or motivation to modify the reference or to combine reference teachings, (2) there must be a reasonable expectation of success, and (3) the prior art reference(s) must teach or suggest all of the claim limitations. *See MPEP § 2142*. Applicants respectfully assert that these tests of obviousness have not been met in this case.

A. Claims 1-3 and 8-17 over Bourssouira

Claims 1-3 and 8-17 were rejected under 35 U.S.C. § 103(a) as purportedly unpatentable over Bourssouira. This rejection is respectfully traversed.

Applicants assert that a *prima facie* case of obviousness has not been made out against Claims 1 and 8-17 at least because, as explained above, Bourssouira does not disclose all elements of these claims. Specifically, Bourssouira fails to disclose at least the specific ascorbic acid precursors now enumerated in Claims 1 and 8-17. Accordingly, the third *prima facie* obviousness criterion has not been satisfied.

Applicants respectfully request withdrawal of the 35 U.S.C. § 103(a) rejection of Claims 1 and 8-17 over Bourssouira.

B. Claims 1-17 over Bourssouira in view of Wheeler and/or Berry

Claims 1-17 were rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Bourssouira in view of "*The biosynthetic pathway of vitamin C in higher plants*" to Wheeler

et al. ("Wheeler") and/or Published U.S. Patent Application No. 2002/0012979 to Berry et al. ("Berry"). This rejection is respectfully traversed.

Boussouira teaches topically-applicable products containing a lipase, a vitamin precursor ester, and an alcohol. *See, e.g., Boussouira Claim 1.* Contrarily, both Wheeler and Berry teach the ascorbic acid pathway in higher plants and ascorbic acid metabolism in plants, respectively. Neither Wheeler nor Berry disclose or suggest cosmetic application of their findings.

Considering Applicants' invention as a whole and the cited publications as a whole, there is simply no motivation or suggestion to combine and modify the publications as suggested by the Examiner. Moreover, due to the vast differences between *topically-applicable products* of Boussouira and the *plant pathways* of Wheeler and Berry, one of skill in the art would not have reasonably expected success, as there was no indication that either of these differing fields would have applications in the cosmetic field. Finally, the cited publications fail to disclose each and every element of Claims 1-17.

Because not one of the *prima facie* obviousness criteria have been met, Applicants respectfully request withdrawal of the 35 U.S.C. § 103(a) rejection of Claims 1-17 over Boussouira in view of Wheeler and/or Berry.

CONCLUSION

Applicants maintain that the outstanding rejections have been either obviated or rendered moot. From the foregoing, further and favorable action in the form of a Notice of Allowance is respectfully requested and such action is earnestly solicited.

In the event that there are any questions relating to this response, or the application in general, it would be greatly appreciated if the Examiner would telephone the undersigned attorney concerning such questions so that the prosecution of this application may be expedited.

Respectfully submitted,
BURNS, DOANE, SWECKER & MATHIS, L.L.P.

By: 

Erin M. Dunston
Registration No. 51,147

P.O. Box 1404
Alexandria, Virginia 22313-1404
(703) 836-6620

Date: April 25, 2003